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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#9

Applicants	:	Edward LaVALLIE and Lisa RACIE		
Serial No.	:	08/848,439	Art Unit:	1642
Filed	:	May 8, 1997	Examiner:	S. Ungar
For	:	HUMAN SDF-5 PROTEIN AND COMPOSITIONS		

5-11-98

April 17, 1998

Hon. Commissioner of
Patents and Trademarks
Washington, DC 20231

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Restriction Requirement dated March 18, 1998, Applicants provide the following comments.

The claims have been restricted into the following groups:

Group I (claims 1, 3, 5, 7-10 and 14-17), directed to nucleotide sequences of Sequence ID NO:1, and related materials;

Group II (claims 2, 4, 6 and 16), directed to nucleotide sequences of Sequence ID NO:2, and related materials;

Group III (claims 11-13), directed to claims dependent upon claim 10 which comprise additional nucleotide sequence;

Groups IV (claims 18-20, 22, 23 and 25), directed to polypeptides and compositions;

Group V (claim 21), directed to a method of altering regulation of pancreatic genes;

Group VI (claim 24), directed to an antibody to SDF-5 (SEQ ID NO:2); and

Group VII (claim 26), directed to an antibody to SDF-5 (SEQ ID NO:3.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231 on 4/17/98 (Date of Deposit)

Steven R. Lazar
Name of Attorney for Applicant

Signature

4/17/98
Date of Signature

Because election is required, Applicants hereby provisionally elect to prosecute the claims of Group I. Applicants further provisionally elect the species of a. However, the restriction requirement is clearly improper, and Applicants hereby traverse same, for the following reasons:

The claims of Groups I through III should be examined together. These claims are neither distinct from each other nor do they relate to inventions which can be separately searched or used. Accordingly, the claims of these Groups should be examined together. The Examiner has not shown that the nucleotides of SEQ ID NO:1 are in any way distinct from the nucleotides which encode the amino acid sequence of SEQ ID NO:2. In fact, the latter is generic to the former. Similarly, the claims of Group III, which depend from claim 10 should be examined together with the independent claim (Group I), as the subject matter of this group is not distinct. Thus, any search conducted by the Patent Office of any of these three Groups would necessarily involve search of the same subject matter and would result in multiple patent documents each relating to subject matter which is largely duplicative of the others. The public should not be subjected to the burden of examining numerous patent documents in this manner.

Further, the election of species requirement for claims 1, 2 and 18 is improper for the following reasons. These claims each link several species of nucleotide or polypeptide sequences which encode a functional human SDF-5 protein. Under the M.P.E.P., Applicants are permitted to claim a reasonable number of species in a single application. In fact, the Code of Federal Regulations and the M.P.E.P. explicitly state that the presence of a linking generic claim prevents restriction, **even if otherwise proper**. See 37 C.F.R. §1.141; M.P.E.P. §809.03. Thus, the election of species

requirement is improper and should be withdrawn. Applicants request that the Examiner withdraw this requirement.

The claims of Groups IV, VI and VII should be examined together. These claims are not distinct because the antibodies can readily be prepared based upon the polypeptides of Group IV. Accordingly, any search conducted by the Patent Office of any of these three Groups would necessarily involve search of the same amino acid sequence, and would not involve distinct subject matter. Once again, the result would be two subject the public to an unnecessary and improper burden of examining numerous patent documents in order to ascertain the patent status of similar subject matter. There is no justification for requiring Applicants or the public to pursue multiple patents on a protein and its antibodies.

CONCLUSION

For the above reasons, the restriction requirement should be restructured as follows:

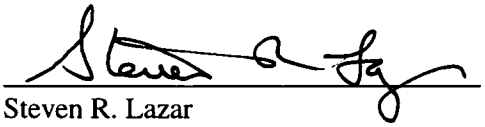
Group I: The claims of present Groups I through III;

Group II: The claims of present Groups IV, VI and VII; and

Group III: The claims of present Group V.

Reconsideration and modification of the restriction requirement as outlined above is requested.

Respectfully submitted,



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